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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,459	07/14/2004	Toshiyuki Ogata	2004-1119A	7571

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EXAMINER

ASHTON, ROSEMARY E

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/501,459

Applicant(s)

OGATA ET AL.

Examiner

Rosemary E. Ashton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,8,9,13,14 and 17-24 is/are rejected.
- 7) ☒ Claim(s) 2,4,7,10,15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/11/05, 7/29/04</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The rejection made in the prior office action is withdrawn because applicant submitted a certified translation of applicant's priority document.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,3,5,6,8,11,17-19,23 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuzawa.

In sections 27 and 30 Matsuzawa teaches a polymer having a fluorinated polycyclic acrylate ester. The polycyclic group is an adamantyl ring. The polymer has other acrylic ester monomers as shown in chemical formula 9 in section 30.

As to claims 17-19 and 23: The claims only have the polymer of claim 1 with no other reagents, thus, the polymer used to reject claim 1 is used to reject these claims.

As to the limitation of the adsorption coefficient at 157 nm it is the examiner's position that because the polymer compound cited in Matsuzawa read on the fluorinated alicyclic compound claimed the compounds in Matsuzawa will inherently have the adsorption coefficient claimed.

3. Claims 1,3,5,6,8,9,11,13,14,17-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Harada et al. US 2003/0008231 cited on applicant's IDS of 7/29/04.

In sections 130-132 Harada teaches a polymer having a fluorinated polycyclic acrylate ester. The polymer has monomer 3 as the fluorinated polycyclic acrylate ester. The polycyclic group is a norbornyl ring. The polymer has other acrylic ester monomers such as ethyladamantyl

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methacrylate. The ethyladamantyl group is an acid dissociable group. Monomer 3 in section 131 meets the limitations of claim 1 with X as an ester group, I=0 and R5 is an ethyl group.

As to claims 17-24: The claims only have the polymer of claim 1 with no other reagents, thus, the polymer used to reject claim 1 is used to reject these claims.

As to the limitation of the adsorption coefficient at 157 nm it is the examiner's position that because the polymer compound cited in Harada read on the fluorinated alicyclic compound claimed the compounds in Harada will inherently have the adsorption coefficient claimed.

Allowable Subject Matter

4. Claims 2,4,7,10,12,15,16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: No prior art was found that had a alicyclic compound with all carbons fluorinated; that the alicyclic group having a hydrophilic group, where the compound and the second monomer are derived from vinyl ether.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosemary E. Ashton whose telephone number is 571-272-1326. The examiner can normally be reached on Mon-Fri, 11:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rosemary E. Ashton
Primary Examiner
Art Unit 1752

January 8, 2006
rea

**ROSEMARY ASHTON
PRIMARY EXAMINER**